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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/894,824 08/29/97 FRIEBE R BAYER9930-WC

IM22/1114
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EXAMINER

MOORE, M

ART UNIT

PAPER NUMBER

1712

DATE MAILED:

25
11/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/894,824

Applicant(s)

Friebe et al.

Examiner

Margaret Glass Moore

Group Art Unit

1712



☒ Responsive to communication(s) filed on Oct 16, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 4, 6 and 8 to 13 is/are pending in the application.

Of the above, claim(s) 11 and 12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 3, 6, 8 to 10 and 13 is/are rejected.

☒ Claim(s) 4 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on Oct. 16, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/894,824 is acceptable and a CPA has been established. An action on the CPA follows.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 3, 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiller et al. in view of Sattlegger et al., for reasons of record.

The Examiner notes that applicants have amended the claims to limit crosslinking agent d) to specific silanes. They note that none of these crosslinking agents include nitrogen atoms. The basis for this rejection, however, relies on the teachings of Sattlegger et al. for the addition of a compound d) to the composition of Schiller et al. Sattlegger et al. teach these crosslinking agents as adhesion promoters. See the abstract thereof. Thus, this combination of references suggests these particular silanes. This amendment does not overcome the rejection of record.

4. Claims 1 to 3, 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck et al. in view of Sattlegger et al.

Eck et al. teach the treatment of chalk, applicants' preferred basic filler, with silyl containing phosphoric acid esters meeting that claimed when R^3 is a silyl containing group. These fillers provide improved results, for instance when incorporated into siloxane elastomers. Note Example 12 on the bottom of column 8. This shows a composition meeting that claimed with the exception of a oxime crosslinking agent rather than an alkoxy crosslinking agent.

As is well known in the siloxane elastomer art and as shown by Sattlegger et al. oxime and alkoxy silane crosslinking agents are often used interchangeably in elastomeric siloxane composi-


tions as they provide comparable crosslinking abilities. See for instance compound (a) on column 2 of Sattlegger et al., in which X can be either alkoxy or an oxime group.

Thus one having ordinary skill in the art would have been motivated by the expectation of comparable results to substitute the oxime crosslinker in Eck et al. with an alkoxy silane crosslinker such as claimed. Note that it is *prima facie* obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jezel* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532.

5. In an effort to expedite prosecution, the Examiner notes that claim 4 is neither taught nor suggested by the prior art. Specifically, upon reconsideration, there is not sufficient suggestion in Schiller et al. to use such a phosphorus compound. Particularly note that this R^3 limitation must be combined with the $n=0$ limitation found in claim 1. Thus the phosphorus compound of claim 4 must contain both an R^3 group as defined therein and 1) an OH group or 2) either a triorganosilyl or diorganoalkoxysilyl radical. It would require picking and choosing from the teachings of Schiller et al. to arrive at such a phosphorus compound. Similarly, the teachings of Eck et al. fail to suggest this phosphorus compound.

6. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) **872-9310**. All other **official** faxes should be sent to (703) **872-9311**. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
Nov. 13, 2000